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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/636,077	08/07/2003	Gary K. John	1095	9844

7590 11/03/2006  
Donald J. Ersler  
725 Garvens Avenue  
Brookfield, WI 53005

EXAMINER

LAUX, JESSICA L

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 11/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/636,077	Applicant(s) JOHN, GARY K.	
	Examiner Jessica Laux	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 7, 14 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 8, 9, 13, 15, 16 and 20 is/are rejected.
- 7) ☒ Claim(s) 2-4, 10-12 and 17-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/21/2003</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Species I in the reply filed on October 03, 2006 is acknowledged.

Claims 7, 14, 21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 03, 2006.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-6, 8-9, 13, 15-16, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sayer (4831804).

Regarding claim 1: Sayer discloses a method of forming a removable window insulator, comprising the steps of: providing at least four frame members (Sayer discloses four frame members, Col. 2, lines 39-40, so there is an inherent step of providing the four frame members); mitering each end of the at least one of said at least four frame members (where figures 1-3 disclose the ends of the members being mitered, so there is an inherent step of mitering the ends); inserting a compressible seal (where element 60 seals the members together and is compressible as every material is inherently compressible under a certain pressure) between the ends of two adjacent frame members before securing said two adjacent frame members to each other (where the securing means comprises inserting screws, figure 3, and it is inherent that member

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60 is inserted before securing the two frame members as the screws penetrate the sealing member 60); sealing at least one pane (20) to an inside edge perimeter of said at least four frame members (where the sealing material is 110, figure 4 and Col 3, lines 45-54); and applying a sealing strip to an outside edge of said at least four frame members (where Sayer discloses in Col. 2, lines 60-63 that grooves are designed to receive insulating material, which is a sealing member, so there is an inherent step of applying the sealing strip).

Regarding claim 5: The method of forming a removable window insulator of claim 1, further comprising the step of: securing said two adjacent frame members to each other with a draw member (102, 104, 106, 108; Col. 4, lines 3-6).

Regarding claim 6: The method of forming a removable window insulator of claim 1, further comprising the steps of: applying a top seal strip (110) to a front peripheral edge of each one of said at least one pane; and applying a bottom seal strip (26) to a bottom peripheral edge of each one of said at least one pane (figure 4, where 26 bears on a bottom peripheral edge of the pane at the bottom member of the frame).

Regarding claim 8: The method of forming a removable window insulator of claim 1, further comprising the steps of: adjusting at least one said draw member to fit said removable window insulator into a window frame (i.e. screwing the draw member, as above, all the way in so that it does not protrude, therefore allowing the window insulator to fit into a window frame).

Regarding claim 9: Sayer discloses a method of forming a removable window insulator, comprising the steps of: providing at least four frame members (Sayer

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discloses four frame members, Col. 2, lines 39-40, so there is an inherent step of providing the four frame members); mitering each end of the at least one of said at least four frame members (where figures 1-3 disclose the ends of the members being mitered, so there is an inherent step of mitering the ends); inserting a compressible seal (where element 60 seals the members together and is compressible as every material is inherently compressible under a certain pressure) between the ends of two adjacent frame members before securing said two adjacent frame members to each other with a draw member (102, 104, 106, 108; Col. 4, lines 3-6, it is inherent that member 60 is inserted before the frame members are secured as the screws penetrate the sealing member 60); sealing at least one pane (20) to an inside edge perimeter of said at least four frame members (where the sealing material is 110, figure 4 and Col 3, lines 45-54); and applying a sealing strip to an outside edge of said at least four frame members (where Sayer discloses in Col. 2, lines 60-63 that grooves are designed to receive insulating material, which is a sealing member, so there is an inherent step of applying the sealing strip).

Regarding claim 13: The method of forming a removable window insulator of claim 9, further comprising the steps of: applying a top seal strip (110) to a front peripheral edge of each one of said at least one pane; and applying a bottom seal strip (26) to a bottom peripheral edge of each one of said at least one pane (figure 4, where 26 bears on a bottom peripheral edge of the pane at the bottom member of the frame).

Regarding claim 15: The method of forming a removable window insulator of claim 9, further comprising the steps of: adjusting at least one said draw member to fit

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said removable window insulator into a window frame (i.e. screwing the draw member, as above, all the way in so that it does not protrude, therefore allowing the window insulator to fit into a window frame).

Regarding claim 16: Sayer discloses a method of forming a removable window insulator, comprising the steps of: providing at least four frame members (Sayer discloses four frame members, Col. 2, lines 39-40, so there is an inherent step of providing the four frame members); mitering each end of the at least one of said at least four frame members (where figures 1-3 disclose the ends of the members being mitered, so there is an inherent step of mitering the ends); inserting a compressible seal (where element 60 seals the members together and is compressible as every material is inherently compressible under a certain pressure) between the ends of two adjacent frame members before securing said two adjacent frame members to each other with a draw member (102, 104, 106, 108; Col. 4, lines 3-6, it is inherent that member 60 is inserted before the frame members are secured as the screws penetrate the sealing member 60); sealing at least one pane (20) to an inside edge perimeter of said at least four frame members (where the sealing material is 110, figure 4 and Col 3, lines 45-54); and applying a sealing strip to an outside edge of said at least four frame members (where Sayer discloses in Col. 2, lines 60-63 that grooves are designed to receive insulating material, which is a sealing member, so there is an inherent step of applying the sealing strip); and adjusting at least one said draw member to fit said removable window insulator into a window frame (i.e. screwing the draw member, as above, all the

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way in so that it does not protrude, therefore allowing the window insulator to fit into a window frame).

Regarding claim 20: The method of forming a removable window insulator of claim 16, further comprising the steps of: applying a top seal strip (110) to a front peripheral edge of each one of said at least one pane; and applying a bottom seal strip (26) to a bottom peripheral edge of each one of said at least one pane (figure 4, where 26 bears on a bottom peripheral edge of the pane at the bottom member of the frame).

***Allowable Subject Matter***

Claims 2-4, 10-12, 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica Laux whose telephone number is 571-272-8228. The examiner can normally be reached on Monday thru Friday, 8:30am to 4:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL

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10/27/2006



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